

S/N : 10/661,048  
Applicant : Qun Ying Lin  
Reply to the Office action dated May 31, 2005

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### **Remarks/Arguments**

Examiner Stephen Rosasco is thanked for the thorough Office Action.

### **In the claims**

Claims 7, 15, 26, 48 and 54 are amended. For support see specification p. 28, line 8. No new matter is added.

### **Election/Restriction**

In the instant office action, Restriction was required to one of the following inventions is required under 35 U.S.C.121:

- I. Claims 1-6, 8-14, 16-20, 22-25, 27-47 and 49-53 drawn to a mask and a method of making, classified in class 430, subclass 5.
- II. Claims 7, 15, 21, 26, 48 and 54-57 drawn to a method of making a semiconductor device, classified in class 430, subclass 311.

### **Provisional Election with Traverse for group 1 claims**

Application provisionally elects to be examined on the invention described by the examiner as Invention I (Claims 1-6, 8-14, 16-20, 22-25, 27-47 and 49-53 drawn to a mask and a method of making, classified in class 430, subclass 5). This election is made with traverse of the requirement under 37 C.F.R.1.143 for the reasons given in the following paragraphs.

The examiner may want to reconsider if dependent claims 49 thru 53 (depend from claim 48) belong in group 2.

### **Respectful Request To Reconsider The Requirement For Restriction**

The Examiner is respectfully requested to reconsider the Requirement for Restriction given in the Office Action. In the instant office action, the Examiner gives the reason for the distinctness of the two inventions as :

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The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown (1) process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product could be used to make a materially different product such as a device with a patterned metal surface.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification; and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (31 CFR 1.143).

MPEP 806.05(h) states:

**806.05(h) Product and Process of Using - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting**

**806.05(h) Product and Process of Using**

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement

To support the restriction, the office action, page 2, states that "In the instant case the product could be used to make a materially different product such as a device with a patterned metal surface." However, applicant respectfully does not think this statement supports the requirements of MPEP 806.05(h). This statement is very speculative. The applicants' claimed invention group I is a optical mask and method of making make. The mask is used to make "semiconductor, electronic and other devices" See specification p. 28, Line 10. Also see

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amended Claims 7, 15, 26, 48 and 54. The example give in the office action, "a device with a pattern metal surface" could be an electronic device.

In addition, claims 7, 15, and 21 are dependent linking claims that are allowable if the parent claims is allowable.

Furthermore, the search must cover both the mask and method class/subclass and the method of making the semiconductor device class/subclass in addition to other related classes/subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive.

In addition, it is respectfully suggested that these reasons are insufficient to place the additional cost of a second Patent Application upon the Applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

#### Pending claims

It is believed that all the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper and the amendment of any claim does not necessarily signify concession of the unpatentability of the claim prior to its amendment.

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### CONCLUSION

In conclusion, reconsideration and withdrawal of the restriction are respectfully requested. Applicant has made election to invention I claims with traverse. Allowance of all claims is requested. Issuance of the application is requested.

It is requested that the Examiner telephone the undersigned attorney at (215) 670-2455 should there be anyway that we could help to place this Application in condition for Allowance.

### Charge to Deposit Account

The Commissioner is hereby authorized to apply any fees or credits in this case, which are not already covered by check or credit card, to Deposit Account No. 502018 referencing this attorney docket. The Commissioner is also authorized to charge any additional fee under 37 CFR §1.16 and 1.17 to this Deposit Account.

Respectfully submitted,

Date: June 3, 2005

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